P06/24

CENTRAL FAX CENTER

AUG 13 2004

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Shi-Hui Zhang, Irene Chen, Hung-Hsum Huang,

Hsien-Chin Liu, and Kuan-Chung Chang

Filing Date: 07/29/2002

Art Unit: 2651

Serial No.: 10/064,598

Docket No.: UTEP0002USA

10

5

Title: SCRATCH-OFF MATERIAL LAYER APPLIED ON OPTICAL

RECORDING MEDIA

To: Commissioner for Patents

15 P.O. BOX 1450

Alexandria, VA 22313-1450

Subject: Information disclosure statement under 37C.F.R.§1.56.

20

25

30

Dear Sir:

This is an Information Disclosure Statement in accordance with the duty to disclose information material to patentability under 37 C.F.R. §1.56. The applicant wishes to make of record the document listed on the accompanying form 1449A/PTO. It is respectfully requested that the examiner initials the cited reference on the form and that it be made of record in the application and that a copy of the initialed form be sent to the applicant with the next communication from the examiner.

Since the IDS is filed before the mailing date of a first Office action on the merits. a petition to request consideration of the information disclosure statement is hereby requested according to 37 CFR §1.97(b). To comply with 37 C.F.R. §1.97(e), which states that each item of information contained in the information disclosure statement

5

10

15

20

25

30

was first cited in any communications from a foreign application not more than three months prior to the filing of the information disclosure statement, each item of information contained in the information disclosure statement was first cited in the communication from the State Intellectual Property Office of People's Republic of China on May 14, 2004 for a counterpart foreign application. The applicant sincerely hopes that the examiner can consider the items contained in this IDS.

According to the requirement set forth in 37 C.F.R.§1.98 and M.P.E.P. 609, the applicants are submitting a copy of the cited reference (China Patent 2462501Y and 2122053U) and a concise explanation of the relevance in this application hereinafter.

The objective of CN 2462501Y is to provide a type of compact disc. According to Fig. 1, the compact disc comprises a transparent substrate 10, a reflective layer 20 formed on the substrate 10, a protective layer 30 formed on the reflective layer 20, and a printing layer 40 formed on the protective layer 30. After applying a layer of printing ink on the printing layer 40, various patterns can be stamped onto the printing layer via a lithographic printing.

CN 2122053U on the other hand, provides a one-time-scratch-off lottery ticket design. According to CN 2122053U, the one-time-scratch-off lottery comprises a paper substrate, a lottery number or distinctive characters or patterns lifting from the surface of the lottery, and a one-time-scratch-off ink layer. By utilizing a silk screen printing method, the ink is ultimately applied onto the surface of the paper substrate. When the lottery number or hidden patterns are to be revealed, the ink can be easily scratched off to expose the lottery number.

The objective of the claimed invention is to provide an optical recording medium having a scratch-off material layer applied on the optical recording medium and to protect the recording medium from illegal copying. According to the preferred embodiment of the claimed invention, the optical recording medium comprises a transparent substrate, a reflect layer formed in the transparent substrate, a protective layer formed on the reflective layer, information formed on a surface of the protective

layer, and at least one opaque scratch-off material layer formed on the protective layer for masking the information.

According to the second embodiment of the claimed invention, the optical recording media comprises a transparent substrate having a first recordable region for recording a first specific data and a second recordable region for recording a second specific data, a reflective layer formed on the transparent substrate, a protective layer formed on the reflective layer without covering the second recordable region, and at least on opaque scratch-off material layer formed on the protective layer for covering the second recordable region. When the scratch-off material layer is not scratched, the first and second specific data are readable data and when the scratch-off material layer is scratched, the first specific data is a readable data and the second specific data becomes a non-readable data. By scratching the scratch-off material layer, the second specific data of the second recordable region under the scratch-off material layer becomes unreadable. Hence, illegal copying of the optical recording medium is greatly prevented.

Essentially, the main difference between the claimed invention and CN 2462501Y is that the claimed invention includes an additional information formed on top of the protective layer and an opaque scratch-off material formed on top of the information-protection layer for protective purposes. Nevertheless, this feature has already been relatively disclosed in CN 2122053U. As a result, it is suggested that the preliminary claims 1-11 to be canceled from the present invention in order to maintain the novelty of the present invention.

25

30

5

10

15

20

Preliminary claims 12 to 38 on the other hand, have been amended and retained to emphasize the protective characteristics of the optical recording medium, as stated in claim 12, "...The optical recording medium comprises at least one opaque scratch-off material layer formed on the protective layer and covering the second recordable region...when the scratch-off material layer is not scratched, both the first and second specific data are readable data and when the scratch-off material layer is scratched, the first specific data is a readable data and the second specific data

becomes a non-readable data." By utilizing this design, illegal copying can be effectively prevented.

In contrast to the present invention, both prior art patents cited above fail to teach or suggest a protective mechanism or function in relation to the one stated above. It is therefore believed that the claimed invention of the present application is substantially different from the prior art patents CN 2462501Y and CN 2122053U.

For convenience, the amended claim 12 of the present application is listed 10 below:

- 12. Optical recording media having a scratch-off material layer comprising:
 - a transparent substrate comprising a first recordable region for recording a first specific data and a second recordable region for recording a second specific data;
 - a reflective layer formed on the transparent substrate;
 - a protective layer formed on the reflective layer, and not covering the second recordable region; and
 - at least one opaque scratch-off material layer formed on the protective layer and covering the second recordable region; wherein when the scratch-off material layer is not scratched, the first and second specific data are readable data, and when the scratch-off material layer is scratched, the first specific data is a readable data and the second specific data becomes a non-readable data.

25

20

15

5

30

Respectfully Submitted,

5 Wintenston

Date: 8/13/2009

Winston Hsu, Patent Agent No. 41,526

P.O. BOX 506

Merrifield, VA 22116

U.S.A.

e-mail: winstonhsu@naipo.com.tw

(Please contact me by e-mail if you need a telephone communication and I will return your call promptly.)

PTO/SB/08A (08-03)
Approved for use through 07/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of knormation unless it contains a valid OMB control number.

Complete if Known Substitute for form 1449/PTO Application Number 10/064,598 07/29/2002 Filing Date INFORMATION DISCLOSURE First Named Inventor Shi-Hui Zhang STATEMENT BY APPLICANT Art Unit 2651 (Use as many sheets as necessary) Examiner Name Attorney Docket Number UTEP0002USA

	· · · · · · · · · · · · · · · · · · ·	·····	U. S. PATENT D		
Exeminer Initials*	Cite No.1	Document Number Number-Kind Code ^{2 (f hosen)}	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant
					Figures Appear
		US-			
		US-			
		US-			
		US-		-	
	!	US-			
	1	US-	 		
		US-	 		
***		US-	~	~	
		US-			-
		ÜS-		· <u>-</u>	
	ļ —	ÚS-			
	 	US-	 	<u>.</u>	<u> </u>
		US-			
		ŰS-			
		US-			
		US-	 		
	 	US-			
		บัธ ^น	 		
		US-	 		

	FORE	IGN PATENT DOCU	MENTS		
Cite No.1		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Linee, Where Relevant Passages Or Relevant Figures Appear	т•
1	CHN-2462501Y	11/28/2001	V*		+
2	CHN-2122053U	11/18/1992			+
					ļ
			· · · · · · · · · · · · · · · · · · ·		ļ
	No.1	Country Code ² Number ¹ -Kind Code ³ (if known) CHN-2462501Y	Cite Foreign Patent Document Publication Date Publication Publicati	No.' Applicant of Cited Document Country Code ³ Number ⁴ -Kind Code ³ (If known) 1 CHN-2462501Y 11/28/2001	Cite No. Poreign Patent Document Publication Date MM-DD-YYYY Provided Pages, Columns, Lines, Where Relevant Pages Or Relevant Figures Appear 1 CHN-2462501Y 11/28/2001

		<u> </u>
Examiner Signature	 Date Considered	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. Applicant's unique citation designation number (optional). See Kinds Codes of USPTO Patent Documents at www.uepto.gov or MPEP 901.04. Enter Office that Issued the document, by the two-letter code (WIPO Standard ST.3). For Japanese patent documents, the Indication of the year of the reign of the Emperor must precede the serial number of the patent document. *Xind of document of document is to place a check mark here if English language Translation is analysis.

Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gamening, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

PAGE 5/24 * RCVD AT 8/13/2004 6:40;36 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:8064986673 * DURATION (mm-ss):06-52